

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Bradley William Caprathe *et al.*

Serial No.: 09/674,812

Filed: April 30, 1999

For: *Succinamide Inhibitors of Interleukin-1B*
Converting Enzyme

Attorney Docket No.: BBI-5060CPUS

(formerly BFA-00701)

Group Art Unit: Not Yet Assigned

Examiner: Not Yet Assigned

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Commissioner for Patents
Washington, D.C. 20231

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December 21, 2001
Date

By: 
Name: Larry Taylor

REQUEST FOR WITHDRAWAL OF NOTIFICATION OF ABANDONMENT

Applicants respectfully request that the Notification of Abandonment dated 11 September 2001. In support of the request, Applicants submit herewith the Declaration of Theresa A. Bresnahan, Patent Docketing Administrator for the Patent Department of the law firm of Foley Hoag, One Post Office Square, Boston, MA 02109, 617-832-1000.

Factual Background

The instant patent application is a U.S. national phase application, filed pursuant to 35 U.S.C. §371, and corresponds to International application no. PCT/US99/09463, filed 30 April 1999. The date of national phase entry in the United States is 06 November 2000. The Transmittal Letter to the United States Designated/Elected Office (Form PTO 1390), marked with Attorney Docket No. BFA-00701 was signed by Beth E. Arnold, Esq., Registration No. 35,430, of Foley Hoag.

At the request of the owner of the above-referenced patent application, Ms. Arnold transferred, on or about May 23, 2001, the complete Foley Hoag prosecution file for the above-referenced patent application to Giulio A. DeConti, Jr., Esq. of Lahive & Cockfield, LLP, 28 State Street, Boston, MA 02109-1784. In reviewing the transferred file, the undersigned noticed that that the Patent Office had apparently not taken any action on the application since the 06 November 2000 national phase entry. Accordingly, on August 31, 2001, the undersigned submitted a Status Inquiry, accompanied by a copy of a Revocation of Prior Powers of Attorney and Appointment of New Power of Attorney (appointing Mr. DeConti and the undersigned, among others, as attorneys of record) , a Notification of Change of Mailing Address, and a Notification of Change of Attorney Docket Number. Copies of these documents are enclosed.

On or about September 19, 2001, a Notification of Abandonment, dated 11 September 2001, was received by the Patent Department of Foley Hoag on September 19, 2001. The Notification indicated that the application was abandoned for failure to respond to a Notification of Missing Requirements dated 19 December 2000. On September 20, 2001, Therese Galante, Foley Hoag Patent Administrator, sent the Notification of Abandonment to Mr. DeConti.

Upon review of the Notification of Abandonment, the undersigned contacted Ms. Arnold to apprise her that the Notification of Missing Requirements was not in the transferred prosecution file. Ms. Arnold referred the matter to Ms. Bresnahan for investigation. In the meantime, the undersigned contacted Ms. Paulette Kidwell of the Patent Office to obtain a copy of the Notification of Missing Requirements. On November 28, 2001, Ms. Kidwell faxed a copy of same to the undersigned.

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Ms. Bresnahan then contacted the undersigned. As set forth in her declaration, Ms. Bresnahan advised the undersigned that she had reviewed the Foley Hoag IP Mail Logs from December 19, 2000, the date of the Notification of Missing Requirements, up to and including January 19, 2001 for Foley Hoag attorney docket no. BFA-00701 and application serial no. 09/674812. She further advised the undersigned that she found no entry under either docket no. BFA-00701 or application serial no. 09/674812 for receipt of a Notification of Missing Requirements dated 19 December 2001. She concluded that Foley Hoag had no record of having ever received the Notification of Missing Requirements dated 19 December 2001.

Applicant submits that although the Notification of Missing Requirements dated 19 November 2000 appeared to have been correctly addressed to Ms. Arnold, document must have been lost in transit from the Patent Office to Foley Hoag, and was never in fact received by Foley Hoag. Accordingly, in view of the foregoing and the Declaration of Ms. Bresnahan, Applicants respectfully request that the Notification of Abandonment dated 11 September 2001 be withdrawn, and further request that a new Notification of Missing Requirements be issued so that Applicants will have the opportunity to comply with the Notification and submit the missing requirements.

If a telephone conversation with Applicants' attorney would expedite the resolution of this matter, the Examiner is invited to call the undersigned at the telephone number indicated below.

Respectfully Submitted,

LAHIVE & COCKFIELD, LLP



Dated: December 21, 2001

Peter C. Lauro, Esq.
Registration No. 32,360
Attorney for Applicant
28 State Street
Boston, MA 02109-1784
(617) 227-7400